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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,240	11/20/2003	Lewis Michael Popplewell	IFF-56	9921

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INTERNATIONAL FLAVORS & FRAGRANCES INC.
521 WEST 57TH ST
NEW YORK, NY 10019

EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/718,240

Applicant(s)

POPPLEWELL ET AL.

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 14-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 5/10/04, 3/21/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13, drawn to a capsule particle comprising fragrance materials having greater than about 60 weight percent with Clog P values, classified in class 424, subclass 489.
- II. Claims 14,15, 18, drawn to a method of encapsulating a fragrance material, classified in class 512, subclass 4.
- III. Claims 16, 17, drawn to an aqueous composition comprising surfactant, non-encapsulated fragrance, and encapsulated particles, classified in class 514, subclass 937.
- IV. Claims 19-21, 27, and 28 drawn to a slurry comprising permeable capsules containing sacrificial solvent and an aqueous produce base containing fragrance, classified in class 424, subclass 400.
- V. Claims 22-26, drawn to a method of making capsules containing high Clog P liquid fragrance materials, classified in class 424, subclass 451.

The inventions are distinct, for the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process

(MPEP § 806.05(f)). In the instant case, the encapsulated particles of invention I can be prepared by entirely different prior art methods, as applicants disclosed in p. 2, second full paragraph. Thus inventions I and II are distinct.

Inventions I and III are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product, and the species are patentably distinct (MPEP § 806.05(j)). In the instant case, the intermediate product, the capsule particle, is deemed to be useful as dry or anhydrous products other than the aqueous composition of the invention II, and the inventions are deemed patentably distinct because there is nothing on this record to show them to be obvious variants.

Inventions I and IV are related as mutually exclusive species in an intermediate-final product relationship. In the instant case, the intermediate product, the capsule particle, is deemed to be useful as dry or anhydrous products other than the slurry composition of the invention II, and the inventions are deemed patentably distinct because there is nothing on this record to show them to be obvious variants.

Inventions I and V are related as process of making and product made. In the instant case, the encapsulated particles of invention I can be prepared by entirely different prior art methods, as applicants disclosed in p. 2, second full paragraph. Thus inventions I and V are distinct.

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the

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method of making encapsulated perfume and the aqueous composition do not share same design or modes of operation.

Inventions II and IV are unrelated. In the instant case, the method of making encapsulated perfume and the slurry composition do not share same design or modes of operation.

Inventions II and V are unrelated. In the instant case, the different inventions II and V do not share same design or modes of operation.

Inventions III and IV are unrelated. In the instant case, the aqueous composition of the invention III and the slurry composition of IV do not share same design or modes of operation.

Inventions III and V are unrelated. In the instant case, the aqueous composition of the invention III and the method of making encapsulated perfume as claimed in invention V do not share same design or modes of operation.

Inventions III and IV are unrelated. In the instant case, the method of making encapsulated perfume and the slurry composition do not share same design or modes of operation.

Inventions IV and V are related as process of making and product made. In the instant case, the slurry composition as claimed in invention IV does not have to be produced by the method of invention V which requires higher Clog P value of the enclosed perfume.

These inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification and

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recognized divergent subject matter. The inventions require a different field of search (see MPEP § 808.02) for the reason given above, and would impose an undue burden on the examiner to examine all the claims as presented. Thus restriction for examination purposes as indicated is proper.

During a telephone conversation with Liz Quirk on August 1, 2006 a provisional election was made without traverse to prosecute the invention of I, claims 1-13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-28 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 10, the expression "greater than about" renders the claim vague and indefinite. For example, does 7, which is less than 8, meet 'greater than about 8', since 6 may be about 8 and 7 is greater than 6? The phrase "greater than about" is a limitation within a limitation, and the metes and bounds of the scope of the claims are unclear.

Claim 11 recites, "fragrance, materials, stabilizers and solvents having a ClogP value of greater than about 3.3". It is not clear whether the ClogP value limitation refers to the mixture of the three components, or just to the fragrance.

The remaining claims are rejected as depending on an indefinite base claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Velazquez et al. (US 6458754 B1).

Velazquez discloses modified starch encapsulated perfume particles. Example 2 shows a mixture of High Impact Active perfume ingredients, which comprises 75 % of perfume materials having Clog P values greater than 3.8. See instant claim 1. The perfume particles are incorporated to laundry compositions in the most preferred amount of 0.05-1 % by weight. See col. 2, lines 37 – 48; instant claims 7 and 13.

Claims 1, 2, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Caswell (US 6958313 B2), as evidenced by (US 5500138).

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Caswell discloses polyvinyl alcohol film encapsulating enduring fragrance materials for fabric softener. See abstract. The example perfume composition of Enduring Perfume A comprises 65 % of perfume materials having Clog P of 4.0 or higher. See instant claim 2; U.S. Pat. No. 5500138, Table 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3, 4, 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caswell as applied to claims 1, 2, and 7.

While Casswell does not specifically exemplify a formulation using hydrophobic solvent of the instant claims, the reference teaches that adding diluents and stablizers such as diethyl phthalate to the formulation is obvious. See col. 43, lines 63-67; col. 49,

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line 66- col. 50, line 35; claims 4, 8, 11, and 12. The reference also teaches that it is preferred to have at least 7 different enduring perfume ingredients, meeting instant claim 10. Examples 3-8 show the amount of perfume materials added in the fabric softer compositions. See instant claim 13.

Although the reference teaches that solvents are used up to 10 % by weight, generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." See In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). In this case, the reference teaches that the solvents enhance stability and clarity of the formulation. It also teaches that low odor detection threshold perfumes can be used up to 20 % to modify the perfume odor character, which suggests that depending on the desired clarity and odor characteristics of the composition, the skilled artisan would have discovered an optimal weight amount for the solvents/stabilizer by routine experimentation.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caswell as applied to claims 1-4 and 7-13 as above, and further in view of Birch et al. (US 6927195 B2).

Caswell does not teach to double-coat the perfume particles.

Birch teaches particles suitable for inclusion in a dry laundry product, comprising a core of swellable material, containing perfume absorbed therein, the core being

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coated with water-soluble encapsulating material impervious to the perfume. See abstract. The coating is to prevent premature evaporation or dissipation from the particles of the loaded perfume until the coating is dissolved on contact with water in use, and also teaches using modified starches. See col. 9, lines 27-63.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the encapsulated perfume particles by double coating the surface, as motivated by Birch, because the latter teaches that the double coating prevents premature evaporation or dissipation of the perfume from the particles until use. The skilled artisan would have had a reasonable expectation of successfully producing encapsulated particles with a longer shelf-life.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 7,122,512 B2.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to a fragrance material, encapsulated by a polymer which is further coated by a cationic polymer. The specification of the '512 patent defines the fragrance material as having preferred Clog P values of greater than 5, and as a mixture of more than 8 materials, as shown in Example 1. See instant claims 1-3, 9-11. The soluble materials for the fragrance material are taught in col. 3, lines 23-31 of the patent. See instant claims 4, 8. A product of the '512 claims 9-10 is defined in Example 3, which contains 0.75 % by weight of the encapsulated perfume particles.

Claims 1-13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 7,119,057 B2.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to a fragrance material, encapsulated by a polymer which is further coated by a cationic polymer. The specification of the '057 patent defines the fragrance material as having preferred Clog P values of greater than 5, and as a mixture of more than 8 materials, as shown in Example 1. See col. 3, lines 23-31; instant claims 1-3, 9-11. The soluble materials for the fragrance material are taught in of the patent. See instant claims 4, 8. A product of

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the '057 claims are defined in Example 9, which contains 1 % by weight of the encapsulated perfume particles.

Claims 1-11, 13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,105,064 B2.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to a fragrance material encapsulated by a polymer. The fragrance material has Cog P values of 1-7, and as a mixture of more than 8 materials, as shown in Example VIII. See instant claims 1-3, 9-11. The soluble materials for the fragrance material are defined in col. 3, lines 20 - 31 of the patent. See instant claims 4, 8. A product of the '057 claims are defined in Example 9, which contains more than 0.5 % by weight of the encapsulated perfume particles.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is (571) 272-8605. The examiner can normally be reached on M-F 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gina C. Yu
Patent Examiner